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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,544	02/06/2001	Thomas Dietz	14186	7213
23389	7590	01/28/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/777,544

**Applicant(s)**

DIETZ ET AL.

**Examiner**

Shengjun Wang

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 5, 2003 has been entered.

#### ***Claim Rejections 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9, 12, 13, 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Macroemulsion" recited in claims 1, 12 and 17-lack support from the application as original filed. This is a new matter rejection.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9, 12, 13, 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claims 1, 12 and 17 recite "macroemulsion," however, the specification or the claims fails to define "macroemulsion." The claims are indefinite as to the size of the oil droplets in the emulsion herein.

***Claim Rejections 35 U.S.C. 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12, 13, 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cauwet-Madin (US Pat. 6,488,780 B2).

The instant claims 1-9 are directed to emulsions which are free of silicone oil and comprise polyether siloxanes of formula (1). The instant claims 12, 13, 15 and 16 are directed to a process for preparing such emulsions. And claims 17-23 are directed to emulsions which comprise 10% by weight or Less of alcohol and at least one polyether siloxane of formula (1). Additional cosmetic or pharmaceutical components are claimed in the dependent claims.

Cauwet-Martin teaches detergent cosmetic compositions. The compositions comprise a washing base and a conditioning system with an oil nanoemulsion, wherein the oil droplets is less than 150 nm (see abstract, col. 1, lines 52-64). The washing base is generally aqueous (see col. 2, lines 29-31). The reference teaches that the aqueous medium can be composed solely of water or a mixture of water and a lower alcohol such as ethanol (see col. 11, lines 11-17). The conditioning system comprises at least one non-ionic amphiphilic lipid, which is preferably

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chosen from polyether siloxanes (see col. 5, lines 25-50; and claims 13 and 15). Suitable oils for the emulsion include animal or vegetable oils (see col. 10, Lines 24-57). Additional co-emulsifiers are taught under the category of ionic amphiphilic lipids (see col. 6, Line 24 through col. 10, line 23). Weight percentages are taught (see col. 10, lines 19-23). Stearic acid is particularly mentioned as a possible component (see col. 3, lines 5-7). Additional active ingredients are taught (See col. 10, line 60 through col. 11, line 2). While all of the claimed limitations are taught by Cauwet-Martin, the reference lacks disclosed examples of the exact same scope as the instant claims. The reference is not anticipatory as it requires some "picking and choosing" to arrive at the claimed compositions and methods.

It would have been obvious to one of ordinary skill in the art to have modified the compositions and methods of Cauwet-Madin by the selection of various components taught therein in order to arrive at cosmetically acceptable compositions. For example, in arriving at a composition that is "free of silicone oils" as claimed, it would be necessary to omit silicone oils from the compositions of Cauwet-Madin. While Cauwet-Martin teaches that silicone oils can also be used in the oil phase (see col. 10, Lines 24-57), the reference does not teach or suggest that silicone oils are necessarily present in the compositions. The motivation for selecting various components taught by Cauwet-Madin is to arrive at a cosmetically acceptable composition. As to the limitation of "macroemulsion," note absent clear definition of this term, it is presumed that oil droplet of 150 nm would meet the limitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-

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4554 ((571)272-0632 after February 3, 2004). The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877 ((571)272-0629 after February 3, 2004). The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Primary Examiner

A handwritten signature in black ink, appearing to be 'S. Wang' with a stylized flourish at the end.

Shengjun Wang

January 23, 2004